

REMARKS

Claims 1-27 and 32-38 were pending when the present Office Action was mailed on April 27, 2009. In this response, claims 1, 3-6, 8-11, 13-15, and 32-36 have been amended to correct informalities and clarify certain features of these claims in order to expedite prosecution of this application; the foregoing amendments are made without prejudice to pursuing these claims in unamended or other forms in a continuation or other application. Accordingly, claims 1-27 and 32-38 are currently pending.

In the Office Action dated April 27, 2009, claims 1-27 and 32-38 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) Claims 1-15 and 32-36 were objected to because of informalities;
- (B) Claims 4, 9 and 14 were rejected under 35 U.S.C. § 112; first paragraph as failing to comply with the written description requirement;
- (C) Claims 1, 3-5, 35 and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Paradiso et al. (USPN 6,404,340);
- (D) Claims 2 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Blair (Pub. No. 2004/0250819);
- (E) Claims 6, 8-11, and 13-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Eckstein et al. (Pub. No. 2001/0040507);
- (F) Claims 7, 12 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Eckstein et al. (Pub. No. 2001/0040507) as applied to claim 6, 11 and 16 and furhter in view of Blair (Pub. No. 2004/0250819);
- (G) Claims 19-20, 23-24 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Bladen et al. (Pub. No. 2003/0163037);
- (H) Claims 21-22, 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Bladen et al.

(Pub. No. 2003/0163037) as applied to claims 20 and 23 and further in view of Schneider (USPN 6,073,043);

- (I) Claims 32-34 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paradiso (USPN 6,404,340) in view of Flaxl (USPN 5,491,715).

As a preliminary matter, the undersigned representative and Nelson Wright wish to thank Examiner Weatherby and Examiner Le for engaging in a productive in-person Examiner's interview on October 22, 2009. During the interview, independent claims and the teachings of Paradiso were discussed; additionally, a technology overview was presented by Mr. Wright. The following remarks summarize and expand upon the points discussed during the October 22nd Examiner's Interview. The applicants accordingly request that this paper constitute the applicants' Interview Summary. The applicants respectfully believe that agreement was reached on the claims in view of the cited art and present the above claim amendments in accordance with that agreement. If the Examiner notices any deficiencies in this regard, the Examiner is encouraged to contact the undersigned representative.

More specifically, the Examiner and the applicant discussed the deficiencies of the Paradiso reference, which is the primary reference for all outstanding rejections. Paradiso teaches a frequency sweeping device which is not adjustable. For example, Paradiso teaches an oscillator sweeping from 40 kHz to 400 kHz at a repetition rate of 30 Hz and fails to teach or disclose adjusting the excitation source to provide further excitation at the marker resonant frequency as disclosed and claimed in the pending application. (Paradiso, col. 4, lns 51-55)

In contrast to Paradiso, the pending application teaches and claims a method for determining a marker resonant frequency which includes a receiver tunable to a resonator frequency. (Specification, [0076]) More specifically, with regard to box 709 of Figure 7 of the pending application, the receiver 208 is adaptable to work in coordination with the excitation source to tune the system 100 to the specific

characteristics of the marker. (Specification, [0077]) In particular, the excitation source 202 has an adjustable frequency that can be tuned in accordance with analysis made by the receiver 208. (Specification, [0077]) As discussed in the October 22nd Examiner's Interview, Paradiso fails to teach or disclose this and other features of the claimed invention. None of the cited prior art references corrects this deficiency and therefore, applicants respectfully request withdrawal of the 102 and 103 rejections.

Claims 1, 3-6, 8-11, 13-15, and 32-36 have been amended to correct informalities and to place the application in better condition for allowance. Accordingly, applicants respectfully request entry of the amendment and acceptance of the RCE.

Dayco/McKesson Disclosure

In accordance with the undersigned's current understanding of the obligations imposed by *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d. 1358 (Fed. Cir. 2003) and *McKesson Information Solutions, Inc. v. Bridge Medical, Inc.*, 487 F.3d 897 (Fed. Cir. 2007), the file histories of the following applications may contain information material to one or more of the pending claims. In assessing the patentability of the pending claims, the Examiner is respectfully requested to review the file history of each of the listed applications, determine whether such applications have "similar subject matter" and, if so, consider each substantive Office Communication and Office Action, including each reference on which a rejection is based, and each paper submitted by applicant therein. If the Examiner requires any further information in this respect, please let the undersigned know.

- a. Application Serial No. 10/749,478, filed on December 31, 2003;
- b. Application Serial No. 10/750,456, filed December 31, 2003;
- c. Application Serial No. 10/750,164, filed December 31, 2003; and

c. Application Serial No. 10/749,960, filed December 31, 2003, now US Patent No. 6,977,504.

In view of the above amendment, applicant believes the pending application is in condition for allowance. Applicant believes no additional fees are due with this response. However, if additional fees are due, please charge our Deposit Account No. 50-0665, under Order No. 341148021US from which the undersigned is authorized to draw.

Dated: 10.27.09

Respectfully submitted,

By _____

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